

### REMARKS

Claims 1, 2, 5-15, 17-18, 38 and 39 are currently pending and under consideration. Claims 1, 2, 5-6, 8-9, 11, 18, 38 and 39 have been amended herein. Favorable reconsideration of the subject application is respectfully requested in view of the following comments.

Please note that claims 3, 4, and 16 were previously cancelled without prejudice or disclaimer in the Reply dated January 30, 2001 and filed on February 2, 2001 in response to the First Office Action dated August 30, 2000.

#### **I. Rejection of Claims 1, 2, 6-12, 14 and 17 Under 35 U.S.C. §102(b)**

Claims 1, 2, 6-12, 14 and 17 stand rejected under 35 U.S.C. §102(b) as being anticipated by Cleef (U.S. 2,248,317) for reasons previously recorded in paper #7, p. 6, paragraph #7. Claim 1 has been amended herein to further define the surface cover as having two or more leaves which are arranged to form a stack of leaves whereby the stack of leaves includes at least a first leaf having a first thickness and a base leaf having a second thickness greater than the first thickness. Such amendments are fully supported by the specification. For example, see page 3, 2<sup>nd</sup> full paragraph. Claims 2, 6-12, 14 and 17 depend from claim 1. Therefore, in view of the amendments to claim 1, withdrawal of the rejection for the above claims is respectfully requested for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference.” *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) (quoting *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677 & USPQ2d 1315, 1317 (Fed. Cir. 1988)). In other words, anticipation exists only if all the elements of the claimed invention are present in a product or process disclosed, expressly or inherently, in a single prior art reference. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984), cert. dismissed sub nom. *Hazeltine Corp. v. RCA Corp.*, 468 U.S. 1228 (1984); see also, MPEP §706.02. In addition, in order to anticipate, the elements in a single reference “must be arranged as in the claim under review.” *Id.*, (quoting *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984)).

As amended, claim 1 of the present invention describes a surface cover comprising two or more leaves arranged to form a stack of said leaves, the stack of said leaves including at least a first leaf with a first thickness ... and a base leaf underlying the first leaf and having a second thickness greater than the first thickness... Cleef does not disclose, teach or suggest a packet of stickers wherein the stickers are of a varying thickness. In particular, Cleef fails to teach or suggest a first sticker having a first thickness and a base sticker having a second thickness greater than the first thickness. Rather, Cleef relates to a packet of stickers of similar size and shape. Therefore, Cleef does not anticipate the present invention with respect to claims 1, 2, 6-12, 14 and 17. In view of the foregoing, withdrawal of the rejection is respectfully requested.

## **II. Rejections of Claims 1, 2, 6, 7, 10, 13 and 17 Under 35 U.S.C. §102(b)**

Claims 1, 2, 6, 7, 10, 13, and 17 stand rejected under 35 U.S.C. §102(b) as being anticipated by Bowskill (U.S. 4,795,669) for reasons previously recorded in paper #7, pp. 5-6, paragraph #6. Claim 1 has been amended herein to further define the surface cover as having two or more leaves which are arranged to form a stack of leaves whereby the stack of leaves includes at least a first leaf having a first thickness and a base leaf having a second thickness greater than the first thickness. The amendment is fully supported by the specification. Claims 2, 6, 7, 10, 13, and 17 depend from claim 1. Therefore, in view of the amendments to claim 1, withdrawal of the rejection for the above claims is respectfully requested for at least the following reasons.

As previously discussed in Remarks Section I of this Reply, every element of the claimed invention must be identically shown in a single reference for that reference to anticipate the present invention as claimed. *See e.g., In re Bond, supra.* As amended, claim 1 of the present invention describes a surface cover comprising two or more leaves arranged to form a stack of said leaves, wherein the stack of said leaves includes at least a first leaf with a first thickness ... and a base leaf underlying the first leaf and having a second thickness greater than the first thickness. Bowskill *et al.* fails to disclose, teach or suggest the limitations recited in the rejected claims of the present invention. Rather Bowskill relates to a stack of sheets or protective shields adhesively secured together whereby the sheets or protective shields are of a uniform shape and size. Bowskill *et al.* fails to teach or suggest the sheets having a varied thickness as is described in the claimed invention. In addition, Bowskill *et al.* fails to teach or suggest a base layer having a mounting adhesive applied thereon being

of sufficient strength to prevent lifting of the stack during removal of individual leaves as described in claim 1. In view of the foregoing, withdrawal of the rejection for claims 1, 2, 6, 7, 10, 13, and 17 is respectfully requested.

### **III. Rejection of Claim 8 Under 35 U.S.C. §102(b)**

Claim 8 stands rejected under 35 U.S.C. §102(b) as being anticipated by Cleef (U.S. 2,248,317) for reasons previously recorded in paper #7, pp. 5-6, paragraph #6. Withdrawal of the rejection is respectfully requested for at least the following reasons. Claim 8 depends from claim 1. In light of the amendments to claim 1, Cleef does not anticipate claim 8 of the present invention for the reasons recited above with respect to claim 1. Therefore, withdrawal of the rejection is respectfully requested.

### **IV. Rejection of Claims 38 and 39 Under 35 U.S.C. §102(b)**

Claims 38 and 39 stand rejected under 35 U.S.C. §102(b) as being anticipated by Cleef (U.S. 2,248,317). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Claim 38 has been amended herein to further define the surface cover as having two or more leaves which are arranged to form a stack of leaves whereby the stack of leaves includes at least a first leaf having a first thickness and a base leaf having a second thickness greater than the first thickness. Such amendments are fully supported by the specification. Claim 39 depends from claim 38. Therefore, in view of the amendments to claim 38, withdrawal of the rejection for the above claims is respectfully requested for at least the following reasons.

As amended, claim 38 of the present invention describes a surface cover comprising two or more leaves arranged to form a stack of said leaves, wherein the stack of said leaves includes at least a first leaf with a first thickness ... and a base leaf underlying the first leaf and having a second thickness. Cleef does not disclose, teach or suggest a packet of stickers wherein the stickers are of varying thickness. In particular, Cleef fails to teach or suggest a first sticker having a first thickness and a base sticker having a second thickness. Rather, Cleef relates to a packet of stickers of similar size and shape. Therefore, Cleef does not anticipate the present invention with respect to claims 38 and 39. In view of the foregoing, withdrawal of the rejection is respectfully requested.

**IV. Rejection of Claims 1-3, 7, 10, 17 and 18 Under 35 U.S.C. §102(b)**

Claims 1-3, 7, 10, 17 and 18 stand rejected under 35 U.S.C. §102(b) as being anticipated by Bloomer *et al.* (U.S. 5,597,634). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Claim 3 was cancelled in a previous reply to the Office Action dated August 30, 2000. Claims 1 and 18, respectively, have been amended herein to further define the surface cover as having two or more leaves, or a plurality of leaves, which are arranged to form a stack of leaves whereby the stack of leaves includes at least a first leaf having a first thickness and a base leaf having a second thickness greater than the first thickness. The amendment to claims 1 and 18 are fully supported by the specification. Claims 2-3, 7, 10, and 17 depend from claim 1. Therefore, in view of the amendments to claims 1 and 18, withdrawal of the rejection for the above claims is respectfully requested for at least the following reasons.

Bloomer *et al.* does not disclose, teach or suggest the label segment layers having a first thickness and the base label layer having a second thickness greater than the first thickness as described in the claimed invention. Instead, Bloomer *et al.* relates to changeable media labels which includes a base label layer having a first adhesive layer having a first strength and label segment layers having a second adhesive strength. Therefore, Bloomer *et al.* does not anticipate the invention as presently claimed in claims 1-3, 7, 10, 17, and 18. In view of the foregoing, withdrawal of the rejection is respectfully requested.

**V. Rejection of Claims 1, 2, 5-9 and 17 Under 35 U.S.C. §102(e)**

Claims 1, 2, 5-9, and 17 stand rejected under 35 U.S.C. §102(e) as being anticipated by Forman *et al.* (U.S. 5,712,012). Claim 1 has been amended herein to further define the surface cover as having two or more leaves which are arranged to form a stack of leaves whereby the stack of leaves includes at least a first leaf having a first thickness and a base leaf having a second thickness greater than the first thickness. The amendment is fully supported by the specification. Claims 2, 5-9, and 17 depend from claim 1. Therefore, in view of the amendments to claim 1, withdrawal of the rejection for the above claims is respectfully requested for at least the following reasons.

Forman *et al.* does not disclose, teach or suggest sheets or layers wherein a first sheet has a first thickness and a base sheet has a second thickness, as is described in the claimed invention. Rather, Forman *et al.* relates to disposable placements packaged in stacks or rolls. Therefore, Forman

*et al.* fails to describe the claimed invention according to 35 U.S.C. §102(e) and thus does not anticipate claims 1, 2, 5-9 and 17 as recited in the present invention. For at least these reasons, withdrawal of the rejection is respectfully requested.

**VI. Rejection of Claim 15 Under 35 U.S.C. §103(a)**

Claim 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bowskill *et al.* (U.S. 4,795,669). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

A 35 U.S.C. §103(a) rejection requires that the claimed invention is obvious in light of the prior art to one of ordinary skill in the art. Obviousness may be established by showing that the prior art motivated or suggested a claimed invention to one of ordinary skill in the art. According to the deficiencies of Bowskill *et al.* previously discussed in Remarks Section II of this Reply, it would not have been obvious to a person of ordinary skill in the art to vary the thickness of the first leaf and the base leaf so that the first leaf has a first thickness and the base leaf underlying the first leaf has a second thickness greater than the first thickness.

Accordingly, withdrawal of the rejection with respect to claim 15 is respectfully requested.

**VII. Conclusion**

The present application is believed to be in condition for allowance in view of the above amendments and comments.

If any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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